



08/990,414

**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/990,414	12/15/97	GARG	S SP035.C3

LM01/1202
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EXAMINER

DONAGHUE, L	
ART UNIT	PAPER NUMBER

2783

DATE MAILED: 12/02/98

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on 12-15-97 and 7-15-98
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire _____ month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 12 - 45 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 12 - 45 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Art Unit: 2783

1. Claims 12-45 are presented for examination.
2. Claims 1-11 have been canceled at the request of applicant.
3. Claims 12-45 are rejected under the judicially created doctrine of double patenting over claims 1-16 of U. S. Patent No. 5,497,499 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: the specification are identical and the claims both the application and patent are open end. As an example Garg et al. (5,497,499) claim 12 corresponds, as follows:

Garg et al. (5,497,499) claimed an instruction buffer (clm 11, lines 1-4), a tag assignment logic (clm 11, lines 32-38), and dependency checking (claim 11, lines 30 -32).

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

4. Claims 12-45 are rejected under the judicially created doctrine of double patenting over claims 1-16 of U. S. Patent No. 5,737,624 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

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The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: the specification are identical and the claims both the application and patent are open end. As an example Garg et al. (5,737,624) claim 12 corresponds, as follows:

Garg et al. (5,737,624) claimed an instruction buffer (clm 1, lines 13-19), a tag assignment logic (clm 1, lines 14-23), and dependency checking (clm 1, lines 14-23 and claim 6).

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Claims 12-45 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by

Nguyen et al. (5,448,705).

See fig, 4-6 and 10-12.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to L. Donaghue whose telephone number is (703) 305-9675. The examiner can normally be reached on M-F from 8:00 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An , can be reached on (703) 305-9678. The fax phone number for this Group is (703) 305-5358.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

LARRY D. DONAGHUE
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to be 'L. Donaghue', written in a cursive style.